

### **Remarks**

Upon entering the above claim amendments, claims 105 - 123 are pending in the instant application. Claims 1-104 have been canceled without prejudice. Applicants reserve the right to pursue in a related application the subject matter of the canceled claims that are not pursued in the current application. New claims 105 – 123 have been added. Support for the new claims can be found in the original filed claims and through out the specification. For example, support for new claim 105 can be found at, e.g., page 22, line 11, original claim 10, original claim 1, original claim 15, original claim 17, original claim 18, original claim 25, original claim 37, original claim 1, page 23, lines 15-16 and 18-21, page 13, 2<sup>nd</sup> paragraph, page 16, lines 3-16, page 15, 1<sup>st</sup> paragraph, page 13, lines 17-18, page 15, last paragraph, page 16, last paragraph, and page 14, third paragraph. Support for claim 106 can be found at, e.g., original claim 1, page 7, line 13, and page 22, lines 26-27. Support for claim 107 can be found in Example 1, and 1D. No new matter has been introduced.

### **IDS**

The Examiner has pointed out that the Information Disclosure Statement filed June 22, 2006 failed to comply with 37 C.F.R. 1.98 (a)(2). Applicants hereby submit a Supplemental Information Disclosure Statement with a copy of each reference cited. Applicants respectfully request that the Examiner review and consider the cited references in examining the instant application.

### **Specification**

The title of the instant application has been objected for not being descriptive.

Applicants have amended the title as the Examiner has suggested.

### **Claim Objections**

Claims 1, 24, 34, 53, and 101 have been objected for certain informalities.

Applicants respectfully submit that in view of the cancellation of the original claims, the objections have been obviated.

### **Claim Rejection, 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

Claims 1-42, 50-53, and 95-103 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as invention.

Applicants respectfully submit that the original claims have been canceled without prejudice, and the new claims, as submitted herewith, clearly set forth the metes and bounds of the invention. Thus, the rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn.

#### **Claim Rejection, 35 U.S.C. § 112, 1<sup>st</sup> Paragraph, Enablement**

Claims 1-19, 21-27, 29-35, 50-53 and 95-103 are rejected under 35 U.S.C. §112, 1<sup>st</sup> paragraph, for lack of enablement.

Applicants respectfully submit that the instant application has provided ample working examples for the claimed compounds, as defined by the new claims. Applicants believe that the new claims satisfy the "Wands" factors, and the enablement rejection should be withdrawn.

#### **Claim Rejection, 35 U.S.C. § 103**

Claims 1-12, 14, 16, 18-42, 50-53 and 95-103 are rejected under 35 U.S.C. § 103(a) as being obvious in view of Faraci et al., U.S. Patent No. 6,103,900 ("Faraci").

Applicants respectfully disagree. To properly determine a *prima facie* case of obviousness, the Examiner "must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." M.P.E.P § 2142. This is important as "impermissible hindsight must be avoided and the legal conclusion must be gleaned from the prior art." *Id.* Four factual inquiries must be made: first, a determination of the scope and contents of the prior art; second, a determination of the differences between the prior art and the claims in issue; third, a determination of level of ordinary skill in the pertinent art; and fourth, an evaluation of evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Three criteria may be helpful in determining whether claimed subject matter is obvious under 103 (a): first, if there is some suggestion or motivation to modify or combine the cited references; second, if there is a reasonable expectation of success; and third, if the prior art references teach or suggest all the claim limitations. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). "Knowledge in the prior art of every element of a patent claim ... is not of itself sufficient to render claim obvious." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Teleflex Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1333-1334 (Fed. Cir. 2002). The issue is whether there is apparent reason to combine (or to modify, in this case) the known elements in the fashion claimed by the patent at issue. *KSR Int'l Co. v. Teleflex, Inc.*

In the instant case, the claimed invention, as defined by the new claims, is not obvious in view of Faraci. First, in Faraci, the pyrazolo-pyrimidine group **is not** substituted by phenyl, whereas according to the present invention, the pyrimidine group of the pyrimidine is substituted

by a phenyl; and additionally the pyrimidine is substituted by a phenyl in a defined position of the pyrimidine group. Secondly, in Faraci, R4 is 2,4,6 trichlorophenyl, 2,4,6-trimethylphenyl, 2,6-dichloro-4-trifluoromethylphenyl, or 4-bromo-2,6-dimethylphenyl, whereas according to the present invention, the residue corresponding to R4 of Faraci is phenyl which is substituted by methyl (R1 according to the present invention) in position 2 and by cyclopropylcarbonylamino in position 5 (-Y-R3 according to the present invention).

Therefore, a skilled person in the art starting with Faraci would have had at least to substitute the pyrazolo-pyrimidine by a phenyl group and, at the same time, to replace a phenyl in position 4 of the Faraci compounds by a phenyl which is substituted by methyl (R1 according to the present invention) in position 2 and by cyclopropylcarbonylamino in position 5 (-Y-R3 according to the present invention) to end up with a compound of the present invention. Faraci does not teach, nor provide any motivation or reasonable expectation of success to such changes.

In view of foregoing, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

#### CONCLUSION

Applicants respectfully request that the amendments and remarks made herein be entered and made of record in the file history of the present application. Withdrawal of the Examiner's rejection and a notice of allowance are requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Respectfully submitted,

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